

TOWNSEND and TOWNSEND and CREW LLP

By : /Dianna L. Smith/  
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

Richard A. Darrell

Application No.: 10/615,582

Filed: July 7, 2003

For: Receipt Presentment Systems And  
Methods

Customer No.: 20350

Confirmation No. 8946

Examiner: Narayanswamy Subramanian

Technology Center/Art Unit: 2193

**APPELLANT'S REPLY BRIEF**  
**UNDER 37 C.F.R. § 41.41**

Mail Stop: Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
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Sir:

This Reply Brief is submitted in response to the Examiner's Answer ("Answer") mailed November 13, 2008. The following remarks are intended to further focus some of the issues in this appeal.

Regarding the 35 U.S.C. § 101 rejection of claim 18, the Appellant and the Examiner seem to be at odds whether a system claim in "means for" construct is rendered non-statutory merely because all elements *could be* practiced in software. The Appellant maintains that the rejection is improper. There is no foundation for the interpretation advanced by the Examiner.

Regarding the rejection of claim 1, the cited references do not teach or suggest "receiving from the consumer computer information that defines at least one user-defined

category based on product information.” The rejection is premised on relegating claim language to non-functional descriptive material. As the Appellant explained in the Appeal Brief, there is no foundation to treat this claim language as non-functional descriptive material. The Examiner's Answer does not address the inapplicability of the cited cases as detailed in the Appeal Brief. The foundational cases cited in the Examiner's Answer (In re Lowry, 32 F.3d 1579, 32 USPQ2d 1034 (Fed. Cir. 1994) and In re Nagi, 367 F.3d 1336, 70 U.S.P.Q.2d (BNA) 1862 (Fed. Cir. May 13, 2004)) are not on point, and the rejection is improper. The rejection of claim 21 is similarly flawed.

The rejection of claim 11 is believed to be improper because one of skill in the art would not be motivated to combine the references as suggested by the Examiner. The Examiner's Answer does not resurrect the utility of the cited references in the face of the clear teaching away discussed in detail in the Appellant's Appeal Brief.

The Appellant also maintains that the cited references could not be successfully combined to produce a working embodiment of the invention of claim 11. Houvener relates to scanning paper receipts. Schultz deals exclusively with electronic environments. There is no receipt generated by Schultz to be scanned by Houvener. Moreover, there is no teaching that allows Houvener to interface with Schultz, so the system produced by the combination would fail to function properly. Hence, claims 1, 11 and 18 are believed to be allowable, at least for this additional reason.

The Appellant respectfully calls the Board's attention to the rejection of claim 18. The use of “Official Notice” appears to be gaining popularity in the examining corps for “facts” that ARE NOT “capable of instant and unquestionable demonstration as being well-known.” When pressed, as here, the supporting art must be interpreted or otherwise explained to justify its

application. That is the antithesis of "instant and unquestionable demonstration." The rejection of claim 18 is believed to be improper, at least for this reason.

Respectfully submitted,

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